

II. Provisional Obviousness-Type Double Patenting Rejection

The Office provisionally rejects claims 1-28, 36-43, and 46-50 under the judicially created doctrine of obviousness-type double patenting over claims 1-2, 5-14 and 16-41 of U.S. Patent Publication No. 2004/0166130. Office Action at page 3.

Applicants respectfully traverse this provisional rejection, at least because no actual double-patenting circumstance can arise until a patent issues from the cited application. Since the above co-pending application is still under consideration, there is the possibility that the claims may change. Applicant further requests that any resolution in the form of submission of a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c), if necessary, be deferred until such patent issues. Accordingly, Applicant respectfully requests the Examiner to withdraw the provisional rejection of the claims.

Applicant also notes that M.P.E.P. § 804 addresses the situation of two co-pending applications. The section indicates that "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application . . . unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. In view of the amendments to the claims and remarks on record to obviate the other rejections, applicants submit that the provisional double patenting rejection should be the only remaining rejection. If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent." See

M.P.E.P. § 804. For at least this additional reason, Applicant requests that any resolution in the form of submission of a Terminal Disclaimer, if necessary, be deferred.

III. Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-28, 36-43, and 46-50 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,342,527 B1 to O'Lenick et al. ("O'Lenick") in view of U.S. Patent No. 6,491,927 B1 to Arnaud et al. ("Arnaud") for the reasons disclosed at pages 4-8 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

The present claims recite a composition comprising in a cosmetically acceptable medium, (1) at least one polyester resulting from esterification of at least one triglyceride of at least one hydroxylated carboxylic acid with a) at least one aliphatic monocarboxylic acid and b) at least one aliphatic dicarboxylic acid, (2) at least one oil of a molar mass ranging from 650 to 10,000 g/mol, and (3) at least one colorant. According to the Examiner, O'Lenick teaches a polyester and process for providing gloss to the skin that comprises the application of an effective amount of the polyester. *Office Action* at p. 4. The Examiner also alleges that O'Lenick teaches "the esterification of castor oil with a fatty acid to produce an intermediate that possesses both an ester and a triglyceride function and that the unique structure of the castor oil coupled with the proper selection of the fatty acid and diacid...make the polyester result in a product that has unique gloss when applied to the skin" *Id.* p. 4-5. In addition, the Examiner also refers to the specific polyester structures at Col. 2 of O'Lenick. *Id.* p. 5-6. However, as recognized by the Examiner, O'Lenick does "not teach the [claimed] polyester in a composition with an oil with a high molecular weight, or a molar mass

ranging from 650 g/mol to 10000 g/mol, or the concentrations of polyester and the other oil that comprise the composition” *Id.* p. 7.

To remedy this deficiency, the Examiner relies on Arnaud, alleging that the reference teaches a cosmetic composition with a saturated and branched C₂₄ to C₂₈ fatty alcohol or fatty acid ester in the form of oil with a high molecular weight . . . and at least one additional oil that is not the triglyceride but holds a high molecular weight. *Id.* The Examiner also states that Arnaud teaches that the composition can contain colorants and waxes which can be cast into appropriate molds, as well as methods for preparing such compositions which contain at least one polyester, at least one other oil or wax, and a method of conferring to the skin. *Id.* p. 8.

The Examiner then goes on to conclude that one of ordinary skill in the art would have been motivated to combine the teachings of O’Lenick with the teachings of Arnaud “due to the overlapping subject matter contained in each, most notably, cosmetic compositions containing polyesters resultant from esterification that can be lipstick as a finished product, for example” and that such a combination, “absent any evidence to the contrary,” would therefore have been *prima facie* obvious. *Id.* Applicants respectfully disagree.

In order to establish a *prima facie* case of obviousness, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” *See In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). The Examiner must meet three basic criteria: (1) the prior art references, taken alone or in combination, must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings; and (3) there must be a reasonable expectation of success. See M.P.E.P. §§ 2143.01 - 2143.03. It is not sufficient to merely "find every element of a claimed invention in the prior art [and for] an examiner to use the claimed invention itself as a blueprint for piecing together elements . . . Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations and quotations omitted).

In the present case, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness at least because she has not provided any evidence of suggestion or motivation to combine the teachings of the cited art.

As an initial matter, the mere fact that the two references may or may not contain some overlapping subject matter does not provide sufficient motivation or guidance to instruct the skilled artisan to make the particular composition of the instant invention. The Federal Circuit has held that "[p]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000) (emphasis added). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the issue in question is not whether the cited art *could* be modified, but whether there was the requisite suggestion to do so. In the present case, the Examiner has pointed to no such suggestion in the cited art or in the prior art as a whole. With respect to the references relied upon, there is no suggestion provided by either O'Lenick or Arnaud to

combine the polyester of O'Lenick with at least one oil of a molar mass ranging from 650 to 10,000 g/mol..

More specifically, although the Federal Circuit has recently stated that the "suggestion test . . . not only permits, but *requires*, consideration of common knowledge and common sense" in determining whether there is motivation to combine the teachings of cited references (*Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 80 USPQ2d 1641, 1651 (Fed. Cir. 2006)), Applicants do not believe that even common knowledge or common sense would have guided one of ordinary skill in the art to make the specifically claimed combination. First, O'Lenick provides almost no disclosure regarding compositions containing its claimed polyesters. The only statements made by O'Lenick regarding the use of their compounds in a cosmetic composition are (1) disclosure of "effective glossing concentration" at col. 5, lines 22-24, (2) a mention that the compounds "are formulated into lipsticks and color cosmetics where they provide a high gloss to the skin" at col. 5, lines 25-27, and (3) that the compounds can be emulsified and applied from aqueous systems using known emulsification techniques. Col. 5, lines 28-30. This constitutes the whole of O'Lenick's discussion of compositions. Nowhere does O'Lenick mention the possibility of adding an oil to its polyesters at all, let alone at least one oil of molar mass from 650 to 10,000 g/mol.

As for Arnaud, the secondary reference, it does indeed teach a polyester (though not overlapping with that of O'Lenick) in a composition which can optionally comprise a high molecular weight oil, but consideration of this fact must be made in light of the Arnaud patent as a whole. What Arnaud actually says is that the fatty phase comprising the polyester "advantageously comprises one or more other fatty substances and in

particular waxes, gums and oils.” Col. 4, lines 40-42. Arnaud then goes on to disclose a long list of possible oils that stretches from col. 4, line 62 to col. 5, line 27.

Hydrogenated polyisobutenes are only one entry in this list, and nowhere is there any guidance in the reference to choose this particular oil.

Upon careful inspection, it is Applicants’ view that the Examiner appears to have pieced together the present invention from the prior art, improperly using the present specification as a blueprint. Mere overlapping subject matter so broad as cosmetic compositions containing polyesters, does not provide sufficient motivation nor expectation of success. Such hindsight is improper. *See In re Rouffet*, 149 F.3d at 1357. Further, “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *See In re Rouffet*, 47 U.S.P.Q.2d at 1458.

As the Examiner has provided no evidence for motivation or suggestion to combine the teachings of the cited prior art, and thus has failed to make a *prima facie* case. Applicants respectfully request that the rejection under § 103(a) over O’Lenick and Arnaud be withdrawn.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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